## REMARKS

Claims 1-7 and 12-18 are pending in this application. Applicant has amended claims 2, 12 and 14. Applicant has addressed the claim objections and is traversing the claim rejections.

## Claim Objections

The Examiner objected to claim 2 and 12-14 because of informalities. Applicant has amended the claims 2, 12 and 14 to address the Examiner's concerns.

Applicant now believes that claims 2, and 12-14 are now in condition for allowance.

## Response to 35 U.S.C. §103 Rejection

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner rejected claims 1, 3-7, 15 and 17 under 35 U.S.C. 103(a) as being unpatentable over Woo et al. US Patent No. 6,125,135 in view of applicant's admitted prior art on page 8, lines 7-10.

*Not all claim limitation taught or suggested by cited art*

The prior art reference of the '135 patent in view of the page 8, lines 7-10 of the patent application, does not teach or suggest all of Applicant's claim limitations. The Examiner stated in the Office Action that the'135 patent fails to teaches that the IF filter is an active filter it also fails to teach that the noise bandwidth of the GPS receiver is set by the IF active filter. The Examiner goes on to state that "configuring the IF filter as an active filter is old and well established in the art given that, it would have been obvious to one skilled in the art to configure Woo et al. as an active filter as such filter consumes less chip area."

The '135 patent does not teach using an IF active filter, thus the element is missing. The act of configuring an active filter is irrelevant if the element of an active filter is not taught or suggested by the references.

Therefore, claims 1, 3-7, 15 and 17 are in condition for allowance because not all elements are taught by the combination of references cited by the Examiner.

*Must be some suggestion or motivation to combine*

A prima facie case of obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings of the '135 patent with knowledge of one of ordinary skill in the art of configuring an active filter. The combination of the '135 patent and the knowledge of configuring, in general, lacks any suggestion or motivation for making the combination. Any such objective reason can only be found in the teaching of the application in suit. Further, even if the mere fact that the prior art could be modified as proposed by the Examiner, it is not sufficient to establish a prima facie case of obviousness, In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Therefore, the cited art cannot be combined because all the elements of Applicant's amended claims 1, 3-7, 15 and 17 are not found.

*There must be a reasonable expectation of success*

Prima facie obviousness requires that there must be a reasonable expectation of success when prior art is modified or combined. The '135 patent does not teach or describe using an active filter. Thus, this reference teaches away from using an active filter.

In summary, the combination of the above references does not meet the three basic criteria to establish a prima facie case of obviousness and Applicant respectfully submits that claims 1, 3-7, 15 and 17 are now in condition for allowance.

With regards to claims 2 and 16 being rejected under 35 U.S.C. 103(a) as being unpatentable over the '135 patent, admitted prior art and in view of Ciccarelli et al. (US Patent No. 6,359,940, claims 2 and 16 are dependent claims that depend from allowable independent claims as explained above. Applicant also reiterate the previous remarks made about claims 1, 3-7, 15 and 17 herein and for the same reasons believes that claims 2 and 16 are in condition for allowance.

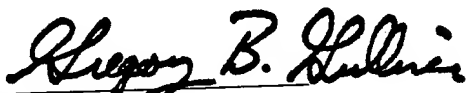
**Response to Double Patenting Rejection**

The Examiner relies on Tso et al (US Patent No. 6,856,794) in view of Woo et al. (US Patent No. 6,125,135) when issuing this rejection. Applicant is traversing this rejection. A double Patenting Rejection based on the combination of two references is improper. Neither patent claims the same thing as the current patent.

## Conclusion

In view of the foregoing discussion and the terminal disclaimer, Applicant respectfully submits that claims 1-7 and 12-18 as presented and in view of the amendments and remarks above are in a condition for allowance, for which action is earnestly solicited.

Respectfully submitted,

By 

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